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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/936,534	02/03/2003	Catia Bastioli	13929/T/B/A	7100

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EXAMINER	
CANO, MILTON I	
ART UNIT	PAPER NUMBER
1761	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/02/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	09/936,534	BASTIOLI ET AL.	
	Examiner	Art Unit	
	Adepeju Pearse	1761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 March 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2,4,7 and 10-14* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2,4,7 and 10-14* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☒ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *1/15/2002*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant argues that Van Loo is not a proper reference. However, applicant has not submitted copies of the foreign document or an official translation to the foreign document in order to perfect the requirements to overcome the reference. In any event, examiner submits a WO 98/52578, which is an equivalent of the US document to Van Loo for consideration.

1. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, applicant argues that there is no motivation to combine the teachings of the applied references. Claim 1 of the instant application recites chewable articles for animals being made from inulin or mixtures of inulin and/or oligofructans with thermoplastic polymers. Leo discloses in (Col 1, lines 28-31) an article for pets, specifically dogs and cats made from starch with a thermoplastic polymer. However, Leo does not show an article made from inulin. Van Loo teaches a fructan preferably inulin containing composition for the prevention and treatment of colon cancer in a non-bovine mammal (abstract). This composition is a functional food and can be present in any known food form including pet food (col 5 lines 42-50). It would be obvious to one of ordinary skill in the art to modify Leo with the teachings of Van Loo by incorporating inulin as an ingredient for cancer prevention as disclosed. The reason or motivation

to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem. It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant. In re Linter, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972).

2. Applicant argues that neither Van Loo nor Tomka disclose that inulin or mixtures of inulin with thermoplastic polymers can be thermoplastically processed. However, product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985)

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 1-2, 4, 7 and 10-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leo (U.S. Pat. No. 5,419,283) in view of Van Loo et al. (U.S. Patent Number 6,500,805

B2/WO 98/52578)), Guttag (U.S. Pat. No. 5,346,929) and Tomka (U.S. Pat. No. 5,844,023). The references and rejections are incorporated as cited in the previous office action. Applicant's arguments filed 3/16/2006 have been fully considered but they are not persuasive.

6. With regards to claims 4 and 10, Leo discloses in (col 2, lines 59-62), an article made from a degradable polymer consisting of starch.

7. With regard to claim 7, Leo discloses plasticizers including sorbitol and glycerol (col 1 lines 49-54).

8. With regard to claim 11, Leo discloses a chew toy for animals comprising a starch material and a biodegradable thermoplastic polymer. The starch is present at a range from 10-40% by weight (col 1 lines 33-35). However, Leo failed to disclose Inulin. Guttag teaches biodegradable plastic articles such as toys (col 3 lines 40-44) comprising a synthetic plastic polymer, a natural polymer and a polymer attacking agent. The natural polymers are found in nature and are easily broken down by natural decay bacteria. It includes but is not limited to particles of starch, inulin, cellulose and wood (col 2 lines 31-34). This suggests that starch and inulin are obvious equivalents as natural polymers and one of ordinary skill in the art would be able to utilize inulin in forming a toy/chewable article because it is easily broken down by natural decay bacteria.

9. With regard to claim 12, Leo discloses an animal chew toy obtained by processing starch and a thermoplastic polymer in the presence of water or a plasticizer under extrusion coking conditions (col 1 lines 33-41). However, Leo failed to disclose a temperature range for the process or inulin. Tomka teaches a biodegradable polymer mixture consisting of starch and a thermoplastic polymer. The mixture is extruded at a range of temperatures from 80°C to 190°C

(col 15 lines 50-54). Guttag teaches inulin and starch as obvious natural polymer equivalents. It would be obvious to one of ordinary skill in the art to modify Leo with teachings of Guttag and Tomka in order to provide a toy/chewable article because it is easily broken down by natural decay bacteria.

10. With regard to claim 13, Leo discloses a chew toy for animals in the shape of a dog bone (abstract).

11. With regard to claim 14, Leo discloses a chew toy for animals comprising a starch material and a biodegradable thermoplastic polymer. The thermoplastic blend is obtained by processing starch and thermoplastic polymer in the presence of water or plasticizer (col 1 lines 33-37). However, Leo failed to disclose Inulin. Guttag teaches biodegradable plastic articles such as toys (col 3 lines 40-44) comprising a synthetic plastic polymer, a natural polymer and a polymer-attacking agent. The natural polymers are found in nature and are easily broken down by natural decay bacteria. It includes but is not limited to particles of starch, inulin, cellulose and wood (col 2 lines 31-34). This suggests that starch and inulin are obvious equivalents as natural polymers and one of ordinary skill in the art would be able to utilize inulin instead of starch in forming a toy/chewable article because it is easily broken down by natural decay bacteria.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Prior art discloses applicable subject matter.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adepeju Pearse whose telephone number is 571-272-8560. The examiner can normally be reached on Monday through Friday, 8.00am - 4.30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 571-272-1398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Peju Pearse

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